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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,476	03/31/2004	Scott E. Brient	029/001	9516

7590 10/20/2004

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Roswell, GA 30075

EXAMINER	
SUHOL, DMITRY	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,476	BRIENT, SCOTT E.	
	Examiner	Art Unit	
	Dmitry Suhol	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because Claim 1 is rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter.

In analyzing claim 1 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). The preamble of claim 1 characterizes the invention as a "method for executing a fake smoke effect . . .".

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that a fake smoke effect will be predictably

enabled by the steps set forth. Simply allowing a user to open a book in no way enables and provides for an assured result of a smoke effect being executed. If one is to assume that the enablement of a smoke effect is somehow tied to opening of a book, as implied by the applicant, there is simply no assurance that such a book will opened. The method steps rely on the state of mind of the participants rather than an objective standard (i.e. if a user does not want to open the book the method will not take place). The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). It has been held that "an idea of itself is not patentable, but a new device by which it may be made practically useful is." Rubber-Tip Pencil Co. v. Howard, 87 U.S. 498, 507 (1874). Abstarct intellectual concepts are not patentable as they are the basic tools of scientific and technological work, but a "practical application" of the concept to produce a "useful" result is patentable. The "abstract idea" exception refers to disembodied plans, schemes, or theoretical methods. An "abstract idea" is utilized in an invention that is a "process, machine, manufacture, or composition of matter under 35 USC 101, and is "useful" when it has utility. Where the claim covers any and every possible way that the steps may be performed, this is more likely to be a claim to the "abstract idea" itself, rather than a practical application of the idea. For example, in discussing the

mathematical algorithm in Gottschalk v. Benson, the Supreme Court discussed that cases holding that a principle, in the abstract, cannot be patented and then stated:

> Here the "process" claim is so abstract and sweeping as to cover both known and unknown uses of the BCD to pure binary conversion. The end use may...be performed through any existing machinery or future-devised machinery or without any apparatus.

409 U.S. at 68, 175 USPQ at 675. The fact that a claimed method is not tied to a machine, even if the method could be perfomed by a machine, and that it does not recite a transformation of physical subject matter to a different state or thing, is an indication that the method is a disembodied "abstract idea" and is not a practical application, as broadly claimed. Claim 1described a method for executing a "fake smoke effect". The method, as claimed, is considered an "abstract idea" because no concrete and tangible means for accomplishing the method is claimed. The method, as claimed, covers any and every possible way of implementing the method, which indicates that it is directed to the "abstract idea" or concept itself, rather than a practical application of the idea. Therefore claim 1 is directed to nonstatutory subject matter under the "abstract idea" exception.

Claim 1 does not produce a useful, concrete, tangible result in the technological arts since the claimed "abstract idea" does not is not concrete, tangible not provides any usefulness having any real world value. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claim 1 does not define statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch '425. Hirsch discloses a book 20 (col. 4, lines 45-65) which provides for the execution of a fake smoke effect through container 11 and associated fake smoke (col. 3, lines 60+). Hirsch further discloses that his container 11 may be provided on the inside cover portion of the book (col. 3, lines 52-53). Therefore the step of allowing a user to open a book is inherent in the invention of Hirsch since without such a step the invention would be useless, while the step of executing the fake smoke effect in response to a user opening a book is considered to read onto the smoke effect portion located on the inside cover, whereby when a user opens the book (i.e. cover) the smoke effect will be visible and therefore executed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds

Dmitry Suhol

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